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10/622,387	07/17/2003	Edwin Lee Solot JR.	230988-0201	4706

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FOLEY & LARDNER
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LOS ANGELES, CA 90067

EXAMINER

WALSH, JOHN B

ART UNIT	PAPER NUMBER
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2151

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/622,387	Applicant(s) SOLOT, EDWIN LEE	
	Examiner John B. Walsh	Art Unit 2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on amdt of 6/1/07.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
 4a) Of the above claim(s) 12, 13 and 46-56 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-11 and 14-45 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 17 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-11, 14-20, 22, 24-41 and 43-45 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,513,126 to Harkins et al.

As concerns claim 1, a system with at least one server device (server 13; column 6, lines 13-14; 19, 20) and a plurality of client devices (column 7, line 7; workstations 4) communicating content (abstract lines 1-2) to and from the at least one server device via a network, the system comprising a processor (inherent for server to have a processor) programmed for receiving content from at least one of the plurality of client devices and transmitting the content to at least one other of the client devices according to a preferred reception mode (column 7, lines 48-50; abstract; column 4, line 25; column 10, lines 42-45) directly communicated from the at least one other of the client devices to the at least one server device.

As concerns claim 2, the system recited in claim 1, wherein the at least one other of the client devices comprises a plurality of other client devices (column 7, line 7; plurality of workstations 4) and wherein the content is broadcasted by the at least one server device (19,20) to the plurality of other client devices.

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As concerns claim 3, the system recited in claim 2, wherein the content is broadcasted by facsimile (column 7, line 4; column 7, line 50) to the plurality of other client devices.

As concerns claim 4, the system recited in claim 2, wherein the content is broadcasted by electronic mail (column 6, line 19; column 7, line 50) to the plurality of other client devices.

As concerns claims 5 and 38, wherein the preferred reception mode comprises at least one of receiving the content by facsimile and receiving the content by electronic mail (column 7, line 50).

As concerns claim 6, the system recited in claim 5, wherein receiving the content by electronic mail further comprises automatically printing the received content (column 3, lines 15-17; column 10, lines 42-48).

As concerns claims 7, 15 and 39, wherein the preferred reception mode indicates a preferred content reception device associated with the at least one other of the client devices, the preferred content reception device for converting the content to a user perceptible form (abstract-last 4 lines-hardware; column 10, lines 44-45).

As concerns claims 8, 17 and 32, wherein the preferred content reception device is at least one of a facsimile machine, a facsimile printer, and a processing device (column 7, line 50; abstract-lines 2-3).

As concerns claims 9, 18 and 33, wherein the processing device runs at least one of a facsimile application for receiving the content and an electronic mail application for receiving the content (40).

As concerns claim 10, the system recited in claim 7, wherein the preferred reception mode further indicates at least one content provider (device which provides the reception mode;

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abstract-machine) designated to provide the content to the at least one other of the client devices.

As concerns claim 11, the system recited in claim 7, wherein the preferred reception mode further indicates that the content should not be provided to the at least one other of the client devices (column 8, lines 55-60).

As concerns claim 14, a system for selecting a preferred mode for receiving content, the system comprising: at least one first client device (column 7, line 7; workstations 4) adapted for transmitting content; at least one second client device (column 7, line 7; workstations 4) adapted for receiving the content; and at least one server device (server 13; column 6, lines 13-14; 19, 20) adapted for receiving the content transmitted from the at least one first client device and re-transmitting the content to the at least one second client device according to a preferred reception mode (column 7, lines 48-50; abstract; column 4, line 25; column 10, lines 42-45) directly communicated from the at least one second client device to the at least one server device. Note, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

As concerns claim 16, the system recited in claim 15, wherein the preferred content reception device is coupled to the at least one second client device (coupled via network; figure 1).

As concerns claim 19, the system recited in claim 14, wherein the at least one second client device comprises a plurality of second client devices (column 7, line 7; plurality of workstations 4) adapted to receive content; and wherein the at least one server device

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broadcasts the content received from the at least one first client device to the plurality of second client devices according to a preferred reception mode (column 7, lines 48-50; abstract, column 4, line 25; column 10, lines 42-45) communicated directly to the at least one server device by each of the plurality of second client devices.

As concerns claim 20, the system recited in claim 14, wherein the at least one first client device is adapted for transmitting content over a network (abstract).

As concerns claim 22, the system recited in claim 14, wherein the at least one second client device is adapted for receiving content over a network (abstract).

As concerns claims 24 and 29, wherein the at least one server device is adapted for providing a webpage for accepting the content/listing from the at least one first client device (column 6, lines 50-55).

As concerns claim 25, the system recited in claim 14, wherein the content comprises a formatted document (column 10, line 42).

As concerns claim 26, the system recited in claim 14, wherein the at least one server device is adapted for receiving a listing of information (column 7, lines 12-19) associated with a plurality of second client devices (column 7, line 7; workstations 4) adapted for receiving the content according to a preferred reception mode directly communicated from the at least one second client device to the at least one server device.

As concerns claim 27, the system recited in claim 26, wherein the listing is a database file (column 9, lines 20-22).

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As concerns claim 28, the system recited in claim 26, wherein the information comprises at least one of a first name, a last name, a facsimile number, a telephone number and an electronic mail address (figure 4).

As concerns claim 30, a system for selecting a preferred device for receiving content, the system comprising: at least one first client device (column 7, line 7; workstations 4) adapted for transmitting content; at least one second client device (column 7, line 7; workstations 4) associated with a plurality of content reception devices; and at least one server device (server 13; column 6, lines 13-14; 19, 20) adapted for receiving the content transmitted from the at least one first client device and re-transmitting the content to the at least one second client device according to a preferred content reception device selection (column 7, lines 48-50; abstract; column 4, line 25; column 10, lines 42-45) directly communicated from the at least one second client device to the at least one server device such that at least one selected content reception device converts the content to a user perceptible form.

As concerns claim 31, the system recited in claim 30, wherein at least one of the plurality of content reception devices is coupled to the at least one second client device (coupled via network; figure 1).

As concerns claim 34, a method for selecting a preferred mode for receiving content, the method comprising: providing at least one server device (server 13; column 6, lines 13-14; 19, 20) for communicating content to and from a plurality of client devices (column 7, line 7; plurality of workstations 4); receiving content (data sent over the network) from at least one content provider; and transmitting the content to at least one of the client devices according to a preferred reception mode (column 7, lines 48-50; abstract; column 4, line 25; column 10, lines

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42-45) directly communicated from the at least one of the client devices to the at least one server device.

As concerns claim 35, the method recited in claim 34, wherein the at least one of the client devices comprises a plurality of client devices (column 7, line 7; plurality of workstations 4) and wherein the content is broadcasted by the at least one server device to the plurality of client devices.

As concerns claim 36, the method recited in claim 35, wherein the content is broadcasted by facsimile (column 7, line 4; column 7, line 50) to the plurality of client devices.

As concerns claim 37, the method recited in claim 35, wherein the content is broadcasted by electronic mail (column 6, line 19; column 7, line 50) to the plurality of client devices.

As concerns claim 40, a method for providing to an information receiver content received from information providers, the method comprising: providing at least one server device (server 13; column 6, lines 13-14; 19, 20) for receiving the content from the information providers and for transmitting the content to at least one first client device (column 7, line 7; workstations 4) associated with the information receiver; and providing a user interface (40) accessible to the at least one first client device, the user interface including user-selectable operators for enabling the information receiver to select a preferred reception mode, the preferred reception mode (column 7, lines 48-50; abstract; column 4, line 25; column 10, lines 42-45) indicating a preferred content reception device associated with the at least one first client device, the preferred content reception device for converting the content to a user perceptible form.

As concerns claim 41, the method recited in claim 40, wherein providing at least one server device for receiving the content from the information providers comprises programming

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the at least one server device for receiving the content (column 7, lines 12-19; column 7, lines 42-62) from at least one second client device in communication with the at least one server device, the at least one second client device being associated with the information providers.

As concerns claim 43, the method recited in claim 40, wherein the user interface enables the information receiver to select the preferred reception mode during a process for registering the information receiver (when user selects the preferred reception mode, the user is "registering").

As concerns claim 44, the method recited in claim 40, wherein the user interface enables the information providers to upload the content to the at least one server device (column 7, lines 12-19-preferences stored on database/server).

As concerns claim 45, the method recited in claim 40, wherein the user interface enables the information providers to upload a listing of information receivers (column 7, lines 12-19; column 7, lines 45-60) to the at least one server device.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 5,513,126 to Harkins et al.

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As concerns claims 21 and 23, Harkins et al. do not explicitly disclose wherein the network is the Internet. It would have been an obvious design choice to include the Internet as one of the networks being accessed especially since Harkins et al. discloses a gateway such that access between networks can be achieved. The use of the Internet as the network does not provide an unexpected result to one of ordinary skill in the art at the time of the invention.

5. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,513,126 to Harkins et al. in view of U.S. Pat. Pub. 2005/0091327 to Koch.

Harkins et al. '126 do not explicitly disclose a webpage accessible over the Internet.

Koch discloses a webpage accessible over the Internet (figures 10 and 11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a webpage accessible over the Internet, as taught by Koch, in order to provide a means of accessing the users preferences from a remote network. Such a modification is a combination of known elements according to known methods that yields predictable results.

Conclusion


6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892. USPGPub 2003/0074320 disclose automatically printing an email.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Walsh whose telephone number is 571-272-7063. The examiner can normally be reached on Monday-Thursday from 7:00-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 571-272-3440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


John B. Walsh
Primary Examiner
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